UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,885	01/18/2005	Ki Soon Ahn	9983.145USWO	8847

23552 7590 02/09/2007	EXAMINER	
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-13* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *18 January 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim does not clearly state what the method is attempting to achieve.

3.   Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of the claim cannot be determined due to the methodical nature of this apparatus claim. Is this a method claim or not?

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   Claims 1-7 and 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a

composition of matter. As such, they fail to fall within a statutory category. They are, at

best, functional descriptive material *per se.*

Descriptive material can be characterized as either "functional descriptive material" or

"nonfunctional descriptive material." Both types of "descriptive material" are nonstatu-

tory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759.

When <u>functional</u> descriptive material is recorded on some computer-readable medium, it

becomes structurally and functionally interrelated to the medium and will be statutory in

most cases since use of technology permits the function of the descriptive material to be

realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed.

Cir. 1994)

Merely claiming <u>non</u>functional descriptive material, i.e., abstract ideas, stored on a

computer-readable medium, in a computer, or on an electromagnetic carrier signal,

does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that

the claims for an algorithm in *Benson* were unpatentable as abstract ideas because

"[t]he sole practical application of the algorithm was in connection with the programming

of a general purpose computer.").

Claims 1-5, 12 and 13 teach of a consulting system and its components, and do not

provide a tangible, physical article and thus are not statutory.

Claims 6, 7 and 11 are nonstatutory subject matter due to lack of a physical medium to

execute the program mentioned. A recording medium is claimed, but the claim does not

teach the storage of the recorded program.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Eder et

al. (US 2001/0034628 A1).

For claim 1, Eder et al. teaches:

A consulting system using network which provides consulting service of a

specific field to a user, said consulting system comprising: a database system

comprising a first object having questions given to the user and answers selected by the

user [Figure 5A and paragraph 0036], and a second object having a series of processes

[0048] and having answer script for reflecting the process results wherein rules between

the objects are defined depending on corresponding property of the objects [Figure 5A

and paragraph 0048]; and service component for providing an interface screen for the

consulting service to the user via the network [0047], for performing a process where

the user answers the questions supplied by the rules; and for supplying personalized

final answers to the user by performing the answer script as the process result [0047].

Eder et al. teaches of an online automated system and method that uses user input to

derive a financial model. The user is prompted to input answers to financially related

questions and an algorithm is performed on the user input along with extracting

information from databases available on the network to produce information to the user

[0047].

For claim 2, Eder et al. teaches:

The system according to claim 1, wherein the database system further comprises

a third object for providing questions given to the user corresponding to the first object

and explanations for selection of the answers of the user, thereby providing

corresponding contents during the answer process [Figure 14, Figure 15 and paragraph

0030]. Eder et al. teaches the process of providing the user with detailed valuation of

the answers chosen after running the steps of the computer system.

For claim 3, Eder et al. teaches:

The system according to claim 1, further comprising a consulting result

processing unit interworking with the service component, said consulting resulting

processing unit for backing up consulting results [back up results in database, Figure 5A

and paragraph 0048] from the service component and for extracting specific data for

performing a previously defined subsequent process from the back-up consulting results

[Figure 5A]. The drawings of Eder et al. shows the process of receiving input from the

user and backing up the information in an application database and extract specific data

from the backup database [Figure 5A].

For claim 4, Eder et al. teaches:

The system according to claim 3, wherein the consulting result processing unit

transmits the extracted specific data into a predetermined expert using a predetermined

method [method of extracting data into a process, Figure 5A]. Eder et al. teaches the

process of extracting data from the user input and performing a predetermined expert

method of actions to supply the solution [Figure 5A].

For claim 5, Eder et al. teaches:

The system according to claim 1, wherein the service component comprises

protocol for providing contents to at least one or more equipments selected from

personal computer accessible to the network [0049], PDA, wireless terminal,

wire/wireless telephone set and internet phone. According to Eder et al., the computer

system comprises of a client computer and an application server computer that are

interconnected via a network [0049].

For claim 6, Eder et al. teaches:

A recording medium for storing a program by using a database system

comprising a first object having questions given to the user and answers selected by the

user [Figure 5A and paragraph 0036], and a second object having a series of processes

[0048] and having answer script for reflecting the process results wherein rules between

the objects are defined depending on corresponding property of the objects [Figure 5A

and paragraph 0048], said program performed by the following steps comprising: the

first step where questions resulting from the process performed by the rules are

provided to the user interfaced via the network and the user answers the questions; and

the second step of providing final answers to the user by performing the answer script

as a result of the first step [0047]. Claim 6 is the device claim of the system discussed

in claim 1, and is rejected for the same reasons as stated above.

For claim 7, Eder et al. teaches:

The medium according to claim 6, wherein the database system further comprises a third object for providing questions given to the user corresponding to the second object and explanations for selection of the answers of the user, thereby providing explanation defined in the third object to the user corresponding the second object [Figure 14, Figure 15 and paragraph 0030]. Claim 7 is the device claim of the system discussed in claim 2, and is rejected for the same reasons as stated above. For claim 8, Eder et al. teaches:

A content making method to embody a consulting system for providing consulting service of a specific field to a user connected via network, said content making method comprising: the first step of generating a plurality of first objects having properties to set minimum implementation conditions [0053], questions given to the user and answers selected by the user [Figure 5A]; and the second step of defining a series of processes including the first object with another first object and/or another second object and of defining answer script for representing final answers given to the user as a result of the process, thereby generating the second object [Figure 5A, Figure 5B and paragraph 0053]. The drawings and the specification of Eder et al. teaches a system that takes multiple inputs from the user and has multiple phases of questions to be answered and steps to be processed to obtain the final answer.

For claim 9, Eder et al. teaches:

The method according to claim 8, wherein as a compulsory condition for applying the first object to the second object is defined as a property of the second object to the implementation condition of the first object, the compulsory condition precedes the

implementation condition of the first object during the process of implementing contents

set in the second object [Figure 5A and Figure 5B]. The flowchart in the drawings of

Eder et al. shows the process of prompting for questions and receiving answers

preceding the process of defining a final answer back for the user.

For claim 10, Eder et al. teaches:

The method according to claim 8, wherein a property hidden to the user is

provided to the first object [Figure 6]. The first object referred to from claim 8 is

described as the questions given to the user and answers selected by user. The

drawing of Eder et al. shows the retrieval of growth option information from a database

between the user inputs and is hidden from the user [Figure 7].

For claim 11, Eder et al. teaches:

A recording medium to embody a consulting system for providing consulting

service of a specific field to a user connected via network [0047], said recording medium

for storing a program performed by the following steps comprising: the first step of

generating a plurality of first objects having properties to set minimum implementation

conditions [0053], questions given to the user and answers selected by the user; and

the second step of defining a series of processes including the first object with another

first object and/or another second object, and of defining answer script for representing

final answers given to the user as a result of the process, thereby generating the

second object [Figure 5A and Figure 5B]. Eder et al. teaches of a consulting system

that is connected to the user via a network and a plurality of questions and answers to

derive a final answer for the user [Figure 5A and Figure 5B].

For claim 12, Eder et al. teaches:

A consulting system using network wherein a plurality of objects have a rule of interconnection based on conditions [Figure 5A], said consulting system comprising: the first step of providing questions corresponding to a specific object to a user connected via network [0047]; and the second step where the user answers the questions, wherein a next object is determined depending on the answers, and the first step and the second step are repeatedly performed to embody the interactive consultation with the user [Figure 5A and Figure 5B]. Eder et al. teaches through the drawings and specification of a consulting system that is interconnected through a network with the user and provides consultation by providing a plurality of questions and the answers being used to derive a final answer after performing the steps in the flow chart of the figures provided.

For claim 13, Eder et al. teaches:

The system according to claim 12, wherein said objects comprise a first object having questions given to the user and answers selected by the user, and a second object having a series of processes and having answer script for reflecting the process results wherein rules between the objects are defined depending on corresponding property of the objects [Figure 5A and Figure 5B]. The drawings of Eder et al. give a detailed view of how the calculations are made based on the properties associated with each response and the selections made previously.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

a. <u>Heinonen</u> (US 6,418,308 B1) discloses a method for performing an opinion poll utilizing a wireless data transmission connection.

b. <u>Verdi</u> (US 7,027,993 A1) discloses a system, apparatus and method for generating and sharing knowledge over a computer network.

c. <u>Lun</u> (US 2003/0074211 A1) discloses a system and method for online corporate business planning and financial reporting in a network transmission environment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajith Jacob whose telephone number is 571-270-1763. The examiner can normally be reached on M-F 7:30-5:00 EST, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on 571-272-4919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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1/31/2007

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Patent Examiner

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